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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/612,766	07/10/00	HEPWORTH J	23802-250800

TM02/1107
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EXAMINER	
LY,A	
ART UNIT	PAPER NUMBER
2172	

DATE MAILED: 11/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

PTO-90C (Rev. 2/95)

1- File Copy

Office Action Summary	Application No. 09/612,766	Applicant(s) HEPWORTH ET AL.	
	Examiner Anh Ly	Art Unit 2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

2. Claims 1-16 are pending in this application.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 5 and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of Application Serial No. 09/359,924. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 5 and 16 in application 09/612,766 recite similar limitations in claim 1 of the application 09/359,924. They recite the same providing at least one trademark, trade-name, celebrity name, and famous name to be searched; creating a search string; providing a URL address of web page, providing

search results and determining homonyms and phonetic equivalents of the at least one trademark, trade-name, celebrity name and famous name.

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-2, 6-7 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,148,289 issued to Virdy.

With respect to claim 1, Virdy discloses the steps of providing the at least one trademark, trade-name, celebrity name and famous name to be search as claimed (col. 3, lines 42-51; see item 122 in fig. 1); creating a search string including the at least one trademark, trade-name, celebrity name and famous name as claimed (col. 5, lines 33-47); providing a URL address of a web page on the Internet to be searched as claimed (col. 2, lines 26-39 and col. 3, lines 42-51); accessing and searching the web page for hits corresponding to the search string and providing search results of identified hits within the web page as claimed (col. 3, lines 15-41 and col. 4, lines 1-19).

Virdy does not clearly disclose "the at least one trademark, trade-name, celebrity name and famous name , search string and the result of hits". However, Virdy teaches InterNIC database (item 122 in fig. 1 and col. 3, lines 42-51) where records of registered domain names containing company name, contact, street, address and IP addresses as well as trademarks, and trade-name are kept; the search request or queries to be searched as company names that are search strings (col. 5, lines 33-47)and the search result of the web pages as the number of hits (col. 3, lines 16-41 and col. 4, lines 1-19). Therefore, it would have been obvious to one of ordinary skill in the art to employ the teachings of Virdy such as InterNIC database, company names and search result of web pages so as to have method of searching and reporting an incidence of at least one a trademark, trade-name, celebrity name and famous name on an Internet.

With respect to claim 2, Virdy discloses the hyperlinks as claimed (col. 3, lines 26-42, and col. 6, lines 1-12).

Claim 6 is essentially the same as claim 1 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 3, lines 42-51, see item 122 in fig. 1; col. 5, lines 33-47; col. 2, lines 26-39 and col. 3, lines 42-51; col. 3, lines 15-41 and col. 4, lines 1-19), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 7 is essentially the same as claim 2 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 3, lines 26-42, and col. 6, lines 1-12), and is rejected for the same reason as applied to the claim 2 hereinabove.

Claim 12 is essentially the same as claim 1 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 3, lines 42-51, see item 122 in fig. 1; col. 5, lines 33-47; col. 2, lines 26-39 and col. 3, lines 42-51; col. 3, lines 15-41 and col. 4, lines 1-19), and is rejected for the same reason as applied to the claim 1 hereinabove.

Claim 13 is essentially the same as claim 2 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 3, lines 26-42, and col. 6, lines 1-12), and is rejected for the same reason as applied to the claim 2 hereinabove.

9. Claims 3, 8, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,148,289 issued to Virdy in view of US Patent No. 6,141,653 issued to Conklin et al. (hereinafter as Conklin).

With respect to claim 3, Virdy discloses a method for searching and reporting an incidence as discussed in claim 1.

Virdy does not explicitly indicate "an encrypted connection authenticated by a certificate server."

However, Conklin discloses data is kept secure and communications over the Internet by SSL (secure sockets layer) (col. 22, lines 8-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Virdy with the teachings of Conklin so as to have an encrypted connection by a certificate server (SSL) because the combination would provide the data is kept in the InterNic database having a secure location inside an Internet Protocol (IP) firewall at the commerce provider site (Conklin – col. 14, lines 45-55) in the searching information over the Internet network environment.

Claim 8 is essentially the same as claim 3 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 22, lines 8-29), and is rejected for the same reason as applied to the claim 3 hereinabove.

With respect to claim 11, Virdy discloses a system for searching and reporting an incidence as discussed in claim 6.

Virdy does not explicitly indicate "a remote computer system connected to the computer system via the Internet for accessing the software program."

However, Conklin discloses the remote Web including Webserver software (as item 210s in fig. 1d) (col. 21, lines 20-45 and col. 23, lines 10-40).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Virdy with the teachings of Conklin so as to have an encrypted connection by a certificate server (SSL) because the combination would provide the data is kept in the InterNic database having a secure location inside an Internet Protocol (IP) firewall at the commerce provider site (Conklin – col. 14, lines 45-55) in the searching information over the Internet network environment.

Claim 14 is essentially the same as claim 3 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 22, lines 8-29), and is rejected for the same reason as applied to the claim 3 hereinabove.

10. Claims 4-5, 9-10 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,148,289 issued to Virdy in view of US Patent No. 6,144,962 issued to Weinberg et al. (hereinafter as Weinberg).

With respect to claim 4, Virdy discloses a method for searching and reporting as discussed in claim 1.

Virdy does not explicitly indicate, "the search results highlight the trademark, trade name, celebrity name, and famous name found in the web page."

However, Weinberg discloses the highlight the text as claimed (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Virdy with the teachings of

Weinberg so as to have the highlight the text because the combination would provide the InterNIC database for the records of registered domain names containing company name, contact, address and IP address are kept on the multiple search engines of the Internet network environment.

With respect to claim 5, Virdy discloses a process for searching and reporting as discussed in claim 1.

Virdy does not explicitly indicate "the homonyms and phonetic equivalent."

However, Weinberg discloses the spell checker as claimed (col. 20, lines 3-8).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Virdy in view of Hill with the teachings of Weinberg so as to have the step for searching the hidden text, text, titles and domain names because the combination would provide the InterNIC database for the records of registered domain names containing company name, contact, address and IP address are kept on the multiple search engines of the Internet network environment.

Claim 9 is essentially the same as claim 4 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20), and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 10 is essentially the same as claim 5 except that it is directed to a system for searching and reporting an incidence rather than a method (col. 0, lines 3-8), and is rejected for the same reason as applied to the claim 5 hereinabove.

Claim 15 is essentially the same as claim 4 except that it is directed to a software program executing son a computer system for searching and reporting an incidence rather than a method (col. 2, lines 20-26, col. 7, lines 60-67, col. 8, lines 1-8 and col. 17, lines 5-20), and is rejected for the same reason as applied to the claim 4 hereinabove.

Claim 16 is essentially the same as claim 5 except that it is directed to a software program executing on a computer system for searching and reporting an incidence rather than a method (col. 0, lines 3-8), and is rejected for the same reason as applied to the claim 5 hereinabove.

Contact Information

11. Any inquiry concerning this communication should be directed to Anh Ly whose telephone number is (703) 306-4527. The examiner can be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner are unsuccessful, see the examiner's supervisor, Kim Vu, can be reached on (703) 305-4393.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 746-7238 (after Final Communication)

or:

(703) 746-7239 (for formal communications intended for entry)

or:

(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (receptionist).

Inquiries of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

AL

Oct. 11th, 2001.

KIM VU
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TECHNOLOGY CENTER 2100